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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,071	03/11/2004	Kevin J. Murphy	WT0156	5662

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Terence P. O'Brien
Wilson Sporting Goods Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

EXAMINER	
WONG, STEVEN B	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,071	MURPHY ET AL.	
	Examiner	Art Unit	
	Steven Wong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-39,65-89,91 and 92* is/are pending in the application.

4a) Of the above claim(s) *29-39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *65-89,91 and 92* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

1. Claims 80-89, 91 and 92 are objected to because of the following informalities: the language "having and" in claim 80 is inapt. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 65, 66, 74, 78, 79, 80, 81, 91 and 92 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horkan (5,570,882). Regarding claims 65, 66, 78-81, 91 and 92, Horkan discloses a football construction including lacing (110) that uses hook and loop fastener elements (120). Note claims 3 and 4 of Horkan stating that the laces may comprise the hook or loop elements. The hook and loop elements are seen as being inherently compressible, resilient and tactile. The lacing defines a plurality of transversely extending lace segments and a plurality of longitudinally extending segments. The examiner takes Official Notice that hook and loop fasteners sold under the trade name VELCRO

are well known in the art to be formed from plastic. The plastic would inherently possess the tensile strength as recited.

In the alternative, it would have been obvious to one of ordinary skill in the art to utilize a plastic that has the recited ranges as the applicant has not shown the criticality for the claimed ranges and it appears that a plastic used in VELCRO would accomplish similar purposes.

Regarding claim 74, because VELCRO is formed from plastic it inherently comprises an "other polymer" as recited.

5. Claims 67-72, 75 and 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Huang (5,344,155). Regarding claims 67 and 82, Horkan reveals a loop fastener for the laces, however, the reference does not expressly state that the fastener comprises inner and outer layers.

Huang discloses hook and loop fasteners for a ball. Note Figure 5 showing the hook fastener (1) comprising an inner substrate (10, 10a) and hook fasteners (12). Thus, it would have been obvious to one of ordinary skill in the art to form the hook fastener of Horkan with an inner substrate in order to properly support the hook fasteners.

Regarding claims 68 and 83, it would have been obvious to one of ordinary skill in the art to utilize one of the listed bonding methods to attach the hook fasteners to the inner substrate in order to properly attach the hook fasteners.

Regarding claims 69 and 84, Huang teaches a substrate with threads (13) therein. Thus, the inner substrate of Huang is seen as a non-woven cloth.

Regarding claims 70, 71 and 85, Huang teaches a rubber or latex threads within the inner substrate.

Regarding claim 72, it would have been obvious to one of ordinary skill in the art to form the strand from plastic in order to take advantage of that material's physical characteristics.

Regarding claims 75 and 86, the hook fasteners are attached only to the top side of the inner substrate.

6. Claims 73 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Martin reveals a game ball construction including a pebbled surface for improving the grip of the ball. It would have been obvious to one of ordinary skill in the art to replace the hook or loop fastener surface of the ball of Horkan with a pebbled surface as taught by Martin in order to provide an alternative means for improving the grip of the ball that does not require the use of the glove.

7.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 65-89, 91 and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,629,902. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the claims of the Patents claim the substantially same limitations as that recited in the application (i.e. game ball having laced region with lacing having inner and outer substrate layers, a tensile strength between 100 and 650 kg/cm^2 and pebbles thereon).

10. Claims 65-89, 91 and 92 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-64 of copending Application No. 10/441,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '556 recite the substantially same limitations as that recited in the instant application (i.e. game ball having laced region with lacing having inner and outer substrate layers, a tensile strength between 100 and 650 kg/cm^2 and pebbles thereon).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Wong
Primary Examiner
Art Unit 3711

SBW
February 15, 2005